

REMARKS

The present remarks are in response to the Office Action dated October 13, 2005, in which the Examiner rejected claims 1-20. The Applicant has canceled claims 7, 13, and 20 and amended claims 1, 8 and 14. Independent claims 1, 8, and 14 include the feature of claims 7, 13, and 20, respectively. Amendment to the specification is made to correct a typographical error. Reconsideration and allowance of pending claims 1-6, 8-12 and 14-19 are respectfully requested.

A. Prior Art Rejections (35 U.S.C. §§ 102 and 103)

The Examiner has rejected claims 1-2, 4-6, 8, 10-12 under 35 U.S.C. §102(a) as being anticipated by Japanese Patent Reference No. 2003-032342A to Oda Tetsuya (hereinafter referred to as "Oda"). The Examiner also rejected claims 3, 9, 14-19 as well as claims 7, 13, and 20 under 35 U.S.C. §103 as being unpatentable over Oda in view of one or more references, U.S. 2002/0160725A1 to Toyota (hereinafter referred to as "Toyoda"), and U.S. 5,485,504 to Ohnsonrge (hereinafter referred to as "Ohnsorge").

Applicant respectfully disagrees. Section 2143 of the MPEP sets forth the following requirements:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, not in the Applicant's disclosure. Section 2143, MPEP Rev. 2.0, May 2004, pg. 2100-129.

The Applicant submits that the amended independent claims 1, 8 and 14 each include, *inter alia*, the limitation that a communication device comprise "a housing including ... a second side surface being concave to generally follow a contour of a user's face." As stated above, to establish a *prima facie* obviousness rejection, the Examiner's prior art must teach or suggest all claim limitations.

However, none of these references, alone or in combination, describe or suggest a communication or wireless device having a second side surface being concave to follow the contour of a user's face, as recited in the amended independent claims.

As acknowledged by the Examiner, the combination of Oda in view of Toyoda does not disclose that the second side surface of the device be concave. Rather, the Examiner cites Ohnsorge as disclosing this missing feature and concludes that that it would have been obvious to one skilled in the art to modify the portable telephone of Oda to arrive at the Applicant's second side surface being concave because this arrangement would provide the necessary shape to ensure good intelligibility of telephone communications, as taught by Ohnsorge.

However, there is no teaching or suggestion in Oda, Toyoda or Ohnsorge, which would motivate a person skilled in the art to modify Oda or Toyoda's portable telephone set to have a concave side surface. In fact, Oda teaches away from what is disclosed in Ohnsorge. Oda aims to facilitate miniaturization in the manufacture of portable phone and to offer a portable phone having a display which will avoid contact with the user's face (see Oda, paragraphs [0001] and [0003]). On the other

hand, Ohnsorge describes that the liquid crystal display of its radio telephone or hand held device must be mounted adjacent to the keypad between the two electroacoustic transducers, i.e., the two ends of the housing where the sound apertures 9 and 10 are located (see Ohnsorge, col. 2, lines 21-23). Therefore, Ohnsorge requires that the liquid crystal display be in direct contact with the user's face when the user uses the electroacoustic tranducers.

Next, Ohnsorge states that the two ends of the housing 1 must be inclined inwards to ensure good intelligibility. However, nothing in Ohnsorge describes or suggests that the side surface, where the speaker and microphone are situated proximate to, must have a concave shape. Ohnsorge merely shows that the front surface of housing 1, but not its side surface, must be inclined.

As described in Applicant's specification:

As shown in FIG. 3, second side surface 310 of housing 302 is generally concave as indicated by radius 350. This particular arrangement, while achieving the benefits discussed above in conjunction with FIGS. 1A and 1B, additionally improves the ergonomics of the wireless communication device 300 since concave second side surface 310 more closely follows the contour of the user's head as second side surface 310 is placed in contact with or proximate to the user's head during conversational use.

However, in Applicant's amended claims 1, 8 and 14, in the housing of the communication device, the second side surface of the housing situated opposite a first side surface is specified to be concave. As clearly illustrated in Ohnsorge (Figs. 1 and 2), it is the front surface of the housing 1 which is inclined and not the sides.

Indeed, the Applicant respectfully submits that modifying Oda's portable telephone in the manner proposed would be counter to the intended use of Oda's portable telephone since Ohnsorge's arrangement would require Oda's portable

telephone to be inclined inwards for no apparent purpose other than to increase manufacturing costs with the undesirable effect of placing the microphone section 8 and speaker section 4 respectively further away from the mouth and ears of the user.

Therefore, Oda, Toyoda or Ohnsorge fail to teach the aforementioned second side being concave, as recited in Applicant's newly amended claims.

Furthermore, the Applicant notes that the Examiner has not demonstrated a motivation to combine the references to support the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated in *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; *there must be some teaching, suggestion, or incentive to make the combination made by the inventor.* (emphasis added)

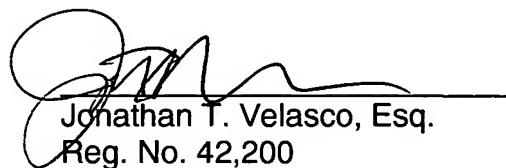
As noted above, the purported combination of Oda, Toyoda and Ohnsorge would be counter to the principles of Oda since such a combination would render the device larger, and therefore contrary to the design principles sought in Oda. Therefore, applicant submits that the limitations of claims 1, 8 and 14 are not taught or suggested by Oda in view of Toyoda, and in further view of Ohnsorge. Since the independent claims 1, 8 and 14 overcome the 35 USC §§ 102 and 103 rejections, the Applicant respectfully requests that each of the dependent claims 2-6, 9-12, and 15-19 respectively, overcome the prior art rejections for at least the same reasons.

B. Conclusion

For all the foregoing reasons, an early allowance of all pending claims is respectfully requested.

Respectfully Submitted,

Dated: Jan 13, 2006



Jonathan T. Velasco, Esq.
Reg. No. 42,200

Jonathan T. Velasco, Esq.
Kyocera Wireless Corp.
Attn: Patent Department
P.O. Box 928289
San Diego, California 92192-8289
Tel: (858) 882-3501
Fax: (858) 882-2485